

**Office Action Summary**

Application No.

09/123,145

Applicant(s)

SEKIGUCHI, KENZO

c/1962

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56 and 57 is/are allowed.
- 6) ☒ Claim(s) 1-42, 47-55, 58 and 59 is/are rejected.
- 7) ☒ Claim(s) 43-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 2/12/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/123,145 is acceptable and a CPA has been established. An action on the CPA follows.

### *Response to Amendment*

2. Applicant's amendments received on 12/19/01 and 2/12/02 have been entered and made of record. Currently, **claims 1-59** are pending.

### *Claim Objections*

3. **Claims 13 and 43** are objected to because of the following informalities:

In **claim 13**, line 11, "data a" should read "data to a";

In **claim 43**, line 10 "indicates" should read "indicating".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. **Claims 1, 2, 4, 6, 9, 11, 13, 25, 36 through 42, 54, and 55** are rejected under 35

U.S.C. 102(e) as being anticipated by Toyoda *et al.* (U.S. Patent Number 5,812,278, cited in the Office action dated 9/25/00).

Regarding **claim 1**, Toyoda discloses a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21) comprising a means (LAN control unit 78, seen in Fig. 22) for connecting to a computer network (LAN or Internet 65), a means (facsimile data communicating unit 74) for connecting to a public telephone network (PSTN 63), a means for receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), a means for receiving transfer destination information of e-mail data from the public telephone network (PSTN 63) by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17, and column 22, lines 1 through 39) and for discriminating the transfer destination information included in the protocol signal (column 22, lines 1 through 16), a means for converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), and a means for designating an e-mail destination of the computer network on the basis of the discriminated transfer destination information (column 22, lines 40 through 49), and

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transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (column 22, lines 49 through 67).

Regarding *claim 2*, Toyoda discloses the apparatus discussed in claim 1 above, and further teaches that the transmission means comprises destination designation means for designating the e-mail destination of the computer network on the basis of the received transfer destination information (column 22, lines 1 through 49), and post-office designation means for designating a desired post-office in an e-mail server (personal computer 64) of the computer network (column 22, lines 49 through column 23, line 4, and column 10, lines 40 through 53, wherein the electronic mail is transmitted according to post office protocol, thereby having the personal computer 64 receive the email in a "post office" corresponding to the designated e-mail destination).

Regarding *claim 4*, Toyoda discloses the apparatus discussed in claim 1 above, and further teaches of a means for registering in advance e-mail address information of the e-mail destination in correspondence with numeral information (column 22, lines 27 through 39), wherein the transfer destination information is received as numeral information (column 22, lines 27 through 39), and the address information of the e-mail destination corresponding to the received numeral information is read out from the storage means to designate the e-mail destination (column 22, lines 40 through 59).

Regarding *claim 6*, Toyoda discloses the apparatus discussed in claim 1 above, and further teaches that the transfer destination information is received by a tone signal (column 21, lines 1 through 17, and column 22, lines 1 through 39).

Regarding *claim 9*, Toyoda discloses the apparatus discussed in claim 4 above, and further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 21, line 1 through 17).

Regarding *claim 11*, Toyoda discloses the apparatus discussed above in claim 9, and further teaches that that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 21, lines 1 through 17).

Regarding *claim 13*, Toyoda discloses a method for a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21), connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), with the method comprising the steps of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17, and column 22, lines 1 through 39), receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), discriminating the transfer destination information included in the protocol signal (column 22, lines 1 through 16), and designating an e-mail destination of the computer network on the basis of the discriminated transfer destination information (column 22, lines 40 through 49), and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 22, lines 49 through 67).

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Regarding *claim 25*, Toyoda discloses a storage medium (ROM 72) which stores a computer program executed by a computer of a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21, column 21, lines 20 through 27), connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), with the computer program having processing of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17, and column 22, lines 1 through 39), processing of receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), processing of converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), processing of discriminating the transfer destination information included in the protocol signal (column 22, lines 1 through 16), and processing of designating an e-mail destination of the computer network on the basis of the discriminated transfer destination information (column 22, lines 40 through 49), and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 22, lines 49 through 67).

Regarding *claim 36*, Toyoda discloses a communication system including a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21, and see facsimile apparatus 51 in Figs. 3 and 12) which is connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), with the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), the computer network (LAN or Internet 65) having an e-mail server (personal computer 64), wherein the

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communication apparatus (facsimile apparatus 71) receives facsimile image data from the public telephone network (PSTN 63) upon reception of a remote instruction including transfer destination information from the public telephone network on the basis of a facsimile communication (column 22, lines 1 through 39), converts the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), discriminates the transfer destination information included in a protocol signal of the facsimile communication (column 21, lines 1 through 17, and column 22, lines 40 through 49), and transmits the e-mail data by designating an e-mail destination based on the discriminated transfer destination (column 22, lines 54 through 59), and the e-mail server (personal computer 64) receives the transmitted e-mail data in a post-office corresponding to the e-mail destination (column 22, lines 49 through column 23, line 4, and column 10, lines 40 through 53, wherein the electronic mail is transmitted according to post office protocol, thereby having the personal computer 64 receive the email in a "post office" corresponding to the e-mail destination).

Regarding *claim 37*, Toyoda discloses a communication apparatus (facsimile apparatus 71, seen in Figs. 21 and 22) comprising means for connecting various types of networks (LAN or Internet 65, and PSTN 63) which have unique formats and addresses, respectively (column 20, line 56 through column 21, line 17), means for receiving information data with destination address data via one of the networks from a transmission source (column 22, lines 1 through 44), wherein the destination address data is included in a standard protocol signal (column 21, lines 1 through 17, and column 22, lines 1 through 39), and means for changing a format of the information data and the destination address data into another format corresponding to another

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type of network by discriminating the destination address data included in the standard protocol signal (column 22, lines 40 through 59).

Regarding *claim 38*, Toyoda discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a computer network (see Fig. 21).

Regarding *claim 39*, Toyoda discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a public telephone network (see Fig. 21).

Regarding *claim 40*, Toyoda discloses the apparatus discussed in claim 37 above, and further teaches that the information data is image data in accordance with predetermined image format (column 20, line 56 through column 21, line 17, and column 22, lines 40 through 59).

Regarding *claim 41*, Toyoda discloses the apparatus discussed in claim 37 above, and further teaches that the format changing means changes the format from a predetermined format to an e-mail format (column 20, line 56 through column 21, line 17, and column 22, lines 40 through 59).

Regarding *claim 42*, Toyoda discloses the apparatus discussed in claim 37 above, and further teaches that the format changing means changes the format from a facsimile format to a predetermined format (column 20, line 56 through column 21, line 17, and column 22, lines 40 through 59).

Regarding *claim 54*, Toyoda discloses a method for a communication apparatus (facsimile apparatus 71, seen in Figs. 21 and 22) comprising connecting various types of networks (LAN or Internet 65, and PSTN 63) which have unique formats and addresses, respectively (column 20, line 56 through column 21, line 17), receiving information data with destination address data via one of the networks from a transmission source (column 22, lines 1



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through 44), wherein the destination address data is included in a standard protocol signal (column 21, lines 1 through 17, and column 22, lines 1 through 39), and changing a format of the information data and the destination address data into another format corresponding to another type of network by discriminating the destination address data included in the standard protocol signal (column 22, lines 40 through 59).

Regarding **claim 55**, Toyoda discloses a computer program (column 21, lines 18 through 23) for a communication apparatus (facsimile apparatus 71, seen in Figs. 21 and 22) comprising program means for connecting various types of networks (LAN or Internet 65, and PSTN 63) which have unique formats and addresses, respectively (column 20, line 56 through column 21, line 17), program means for receiving information data with destination address data via one of the networks from a transmission source (column 22, lines 1 through 44), wherein the destination address data is included in a standard protocol signal (column 21, lines 1 through 17, and column 22, lines 1 through 39), and program means for changing a format of the information data and the destination address data into another format corresponding to another type of network by discriminating the destination address data included in the standard protocol signal (column 22, lines 40 through 59).

6. **Claims 47 through 53, 58, and 59** are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto *et al.* (U.S. Patent Number 5,767,985).

Regarding **claim 47**, Yamamoto discloses a communication apparatus (fax unit 30) comprising a means for connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), means for receiving information data (vocal guide

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message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide message includes a message stating “Specify an E-mail destination in any form...”), means for returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), means for receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), means for receiving another instruction different from the instruction based on the message (being steps 116 or 124, column 9, lines 29 through 36), means for processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as well as seen in Fig. 5 as “no” in all of the steps 228, 236, 242, 250, 256, and 262), and means for changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as “yes” to any of steps 228, 236, 242, 250, 256, and 262).

Regarding *claims 48*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for returning returns the message as voice guidance information (column 8, line 62 through column 9, line 28).

Regarding *claim 49*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for receiving an instruction receives the instruction by a tone signal (column 9, lines 21 through 40).

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Regarding *claim 50*, Yamamoto discloses the apparatus discussed above in claim 49, and further teaches that the tone signal is a DTMF signal (column 9, lines 21 through 40).

Regarding *claim 51*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the information data is image data in accordance with a predetermined image format (column 9, lines 15 through 27).

Regarding *claim 52*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for changing the format changes the format from a predetermined format to an e-mail format (see Fig. 5).

Regarding *claim 53*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for changing a format changes the format from a facsimile format to a predetermined format (see Fig. 5).

Regarding *claim 58*, Yamamoto discloses method for a communication apparatus (fax unit 30) comprising connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), receiving information data (vocal guide message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide message includes a message stating "Specify an E-mail destination in any form..."), returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), receiving another instruction different from the instruction based on the message (being steps 116 or 124, column

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9, lines 29 through 36), processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as well as seen in Fig. 5 as “no” in al of the steps 228, 236, 242, 250, 256, and 262), and changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as “yes” to any of steps 228, 236, 242, 250, 256, and 262).

Regarding *claim 59*, Yamamoto discloses a computer program (column 7, lines 28 through 31) for a communication apparatus (fax unit 30) comprising a means for connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), means for receiving information data (vocal guide message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide message includes a message stating “Specify an E-mail destination in any form...”), means for returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), means for receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), means for receiving another instruction different from the instruction based on the message (being steps 116 or 124, column 9, lines 29 through 36), means for processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as well as seen in Fig. 5 as “no” in al of the steps 228, 236, 242, 250, 256, and 262), and

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means for changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as “yes” to any of steps 228, 236, 242, 250, 256, and 262).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3, 5, 7, 8, 10, 12, 14 through 24, and 26 through 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda *et al.* (U.S. Patent Number 5,812,278, cited in the Office action dated 9/25/00) in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 6/19/01).

Regarding **claim 3**, Toyoda discloses the apparatus discussed in claim 1 above, but fails to specifically teach if the transfer destination information and password information are received from the public telephone network, wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance and if the received password information matches password information set in advance. Bloomfield discloses a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) comprising a means (data network interface 154) for connecting to a computer network (data network 114, column 4, lines 37 through 67), a means (fax comm interface 130) for connecting to a public

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telephone network (public telephone network 108, column 4, lines 5 through 20), a means for receiving facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), a means for receiving transfer destination information (fax interface device ID, E-mail destination address, and check sum) of e-mail data from the public telephone network (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), a means for converting the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), and a means for designating an e-mail destination of the computer network (E-mail destination address) on the basis of the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (step 1080 in Fig. 11C, column 19, lines 37 through 45). Further, Bloomfield teaches that the transfer destination information and password information (identification code) are received from the public telephone network (column 6, lines 30 through 59), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (column 16, lines 35 through 39) and if the received password information matches password information set in advance (step 1048, column 18, lines 17 through 48), and the converted e-mail data is transmitted in accordance with the checking results (column 6, line 47 through column 7, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system

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would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 5*, Toyoda and Bloomfield disclose the apparatus discussed in claim 3 above, and Bloomfield further teaches that the password information is received as numeral information (see Figs. 10 and 10A, column 15, lines 30 through 37, column 16, lines 33 through 39). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 7*, Toyoda discloses the apparatus discussed in claim 6 above, but fails to specifically teach if the tone signal is a DTMF signal. Bloomfield discloses an apparatus having a means for receiving transfer destination information (fax interface device ID, E-mail destination address, and check sum) of e-mail data from the public telephone network (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), whereby the transfer destination information is received by a tone signal (column 5, line 54 through column 6, line 8, and column 10, line 48 through column 11, line 47). Further, Bloomfield teaches that the tone signal is a DTMF signal (column 6, line 63 through column 6, line 5, column 10, line 48 through column 11, line 47, and column 14, lines 36 through 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

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Regarding *claim 8*, Toyoda discloses the apparatus above in claim 1, but fails to specifically teach of a means for selecting whether the public discussed telephone network is released or facsimile reception via the public telephone network is started, when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network. Bloomfield discloses an apparatus (which is discussed above in claim 3) having a means for selecting whether the public telephone network is released or facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network (“time-out “ in step 1042, column 17, line 67 through column 18, line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield’s teachings in Toyoda’s system. Toyoda’s system would easily be modified to include Bloomfield’s teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 10*, Toyoda and Bloomfield disclose the apparatus discussed in claim 5 above, and Toyoda further teaches of receiving identification information by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17). Further, Bloomfield teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 17, line 53 through column 18, line 66).



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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 12*, Toyoda and Bloomfield disclose the apparatus discussed above in claim 10, and Toyoda further teaches that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 21, lines 1 through 17).

Regarding *claims 14 and 26*, Toyoda discloses the method and medium discussed above in claims 13 and 25, respectively, but fails to specifically teach if the remote instruction further includes password information of e-mail data, wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance and if the received password information matches password information set in advance. Bloomfield discloses a method for a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) connected to a computer network (data network 114, column 4, lines 37 through 67) and a public telephone network (public telephone network 108, column 4, lines 5 through 20), with the apparatus having a facsimile communication function, and the method comprising receiving facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), converting the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), discriminating the transfer destination information (fax interface device ID, E-mail

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destination address, and check sum, steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), and designating an e-mail destination of the computer network (E-mail destination address) on the basis of the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (step 1080 in Fig. 11C, column 19, lines 37 through 45). Further, Bloomfield teaches that the transfer destination information and password information (identification code) are received from the public telephone network (column 6, lines 30 through 59), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (column 16, lines 35 through 39) and if the received password information matches password information set in advance (step 1048, column 18, lines 17 through 48), and the converted e-mail data is transmitted in accordance with the checking results (column 6, line 47 through column 7, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 15 and 27*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches that the step of designating the e-mail destination of the computer network on the basis of the received transfer destination information (column 22, lines 1 through 49), and designating a desired post-office in an e-mail server (personal computer 64) of the computer network (column 22, lines 49 through column 23, line 4, and column 10, lines 40 through 53, wherein the electronic mail is transmitted

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according to post office protocol, thereby having the personal computer 64 receive the email in a “post office” corresponding to the designated e-mail destination).

Regarding *claims 16 and 28*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches of registering in advance e-mail address information of the e-mail destination in storage means in correspondence with numeral information (column 22, lines 27 through 39), and receiving the transfer destination information as numeral information (column 22, lines 27 through 39), and reading out the address information of the e-mail destination corresponding to the received numeral information from the storage means to designate the e-mail destination (column 22, lines 40 through 59).

Regarding *claims 17 and 29*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Bloomfield further teaches that the password information is received as numeral information (see Figs. 10 and 10A, column 15, lines 30 through 37, column 16, lines 33 through 39). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield’s teachings in Toyoda’s system. Toyoda’s system would easily be modified to include Bloomfield’s teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 18*, Toyoda and Bloomfield disclose the method discussed in claim 14 above, and Toyoda further teaches that the transfer destination information is received by a tone signal (column 21, lines 1 through 17, and column 22, lines 1 through 39).

Regarding *claims 19 and 30*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 18 and 26, respectively, and Bloomfield further teaches that the

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transfer destination information is received by a tone signal (column 5, line 54 through column 6, line 8, and column 10, line 48 through column 11, line 47), whereby the tone signal is a DTMF signal (column 6, line 63 through column 6, line 5, column 10, line 48 through column 11, line 47, and column 14, lines 36 through 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 20 and 31*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Bloomfield further teaches of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network ("time-out " in step 1042, column 17, line 67 through column 18, line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 21 and 32*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 21, line 1 through 17).

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Regarding *claims 22 and 33*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches of receiving identification information by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17). Further, Bloomfield teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 17, line 53 through column 18, line 66). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 23 and 34*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 21 and 26, respectively, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 21, lines 1 through 17).

Regarding *claims 24 and 35*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 22 and 26, respectively, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 21, lines 1 through 17).

***Allowable Subject Matter***

9. **Claims 56 and 57** are allowed.

10. **Claims 43 through 46** are objected to, but would be allowable if rewritten to overcome the objection noted above to claim 43.

11. The following is a statement of reasons for the indication of allowable subject matter:

Regarding independent *claims 43, 56, and 57*, in the examiner's opinion, it would not have been obvious to a person of ordinary skill in the art at the time the invention was made to have a system receive facsimile image data from a transmitting source via the public telephone network, return a message in response to a request received from the transmitting source via the public telephone network, receive a first instruction generated based on the message returned by the returning means, receive a second instruction that indicates a facsimile communication without reception of the first instruction, convert the received facsimile image data into an e-mail data format, process the received facsimile image data without performing the converting in a case where the second instruction is received, and then transmitting the converted e-mail data. The closest prior art, Bloomfield (U.S. Patent Number 6,025,931), as well as Yamamoto *et al.* (U.S. Patent Number 5,767,985) fail to teach of all these features in the limitations, particularly the limitations of receiving a second instruction that indicates a facsimile communication without reception of the first instruction, and processing the received facsimile image data without performing the converting in a case where the second instruction is received, which were added in the amendment dated 12/19/01. Because of this, the claims are rendered allowable.

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*Citation of Pertinent Prior Art*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Feder** (U.S. Patent Number 5,872,845) discloses a system that transmits received facsimile data as e-mail;

**Hochman** (U.S. Patent Number 5,838,685) discloses a system of receiving facsimile communications, and converting them into electronic mail for subsequent transmission, whereby the destination information is included in a facsimile protocol signal;

**Hsieh** (U.S. Patent Number 5,838,461) discloses a system that receives facsimile data and forwards it as electronic mail to a desired recipient..

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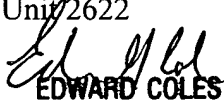
*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

jrj  
April 1, 2002

J.R.P.  
Joseph R. Pokrzywa  
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